

REMARKS

I. STATUS OF THE CLAIMS

The Examiner has rejected all of the pending claims. No changes have been made to the claims. The Examiner's rejection is respectfully traversed below. Therefore, claims 1, 5, 9, 10, 17, 19, 20, and 22-29 remain pending and under consideration.

No new matter has been added. Approval and entry is respectfully requested. The Examiner's rejections are traversed below.

II. CLAIMS 1, 17, 20, 23, 25, AND 29 ARE REJECTED UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER NISHIMOTO (PUB. NO. US 2002/0155857) IN VIEW OF HOTTA ET AL. (PATENT ABSTRACT OF JAPAN PUBLICATION NUMBER 05181603).

The Examiner cites page 1, paragraphs 9 and paragraphs 52-53 of Nishimoto to assert Nishimoto discloses the present invention as recited, for example, in claim 1. The Examiner asserts Nishimoto discloses the finger is shifted while it is in contact with the sensor window so as to set the pointer to a desired menu among menus displayed on the LCD.

On page 5 of the Office Action, the Examiner further asserts "the operational mode of the pointing device is changing relative to the finding of the shifting direction (i.e., determination of the direction in which the operational object (cursor or pointer) can be moved) and the shift distance of the finger (direction of which the pointing device can be operated))."

Nishimoto discloses an optical sensor for reading an optical image of a finger that is used to shift a pointer based upon movement of the finger. (see Abstract). Therefore, Nishimoto merely discloses a pointer is moved around an LCD screen based on movement of the user's finger detected by an optical sensor. (see Abstract). However, Nishimoto fails to disclose the present invention as recited, for example, in claim 1. For example, paragraph 9, cited by the Examiner, discloses "the information display section displays information and a pointer used for selecting the information. The Sensor section reads an optical image of a finger and detects movements of the finger. Based upon the movement of the finger detected by the sensor section, the control section shifts the pointer." Similarly, paragraphs 52 and 53, cited by the Examiner, simply discloses "based upon the shifting direction and the shift distance of the finger thus found, CPU 10 shifts the pointer displayed on the LCD 3 through LCD interface 16." Neither of these cited passages disclose *changing the operation mode of the*

pointing device according to contents displayed on the display screen at the time the pointing device is operated, as recited, for example, in claim 1.

The Examiner concedes, "Nishimoto does not specifically disclose a device wherein the control unit defines the direction **in advance** in which said pointing device can be operated." (see page 5 of the Office Action). Therefore, the Examiner relies on Hotta to disclose "a device wherein to precisely shift a cursor on a display in the completely horizontal or vertical direction by operating the cursor while pressing a switch provided on a mouse. The shift extends of a mouse are inputted (sic) a CPU from a horizontal component and a vertical component (see Abstract)."

The passage in Hotta, cited by the Examiner simply describes a mouse that has a horizontal encoder and a vertical encoder. (see abstract). If the user presses a button on the mouse, then the horizontal and vertical encoders are compared such that only the output from the encoder having the larger value is input to the CPU, thus the pointer only moves in either vertical or horizontal directions. (see Abstract). However, for example, claim 1, recites a *control unit for changing an operation mode of said pointing device according to contents displayed on said display screen at the time said pointing device is operated*. For example, claim 1 also recites *the control unit determines a direction in which said operational object can be moved on said display screen according to said operation mode, and defines the direction in advance in which the operational object can be moved on said display screen, as a current direction in which said pointing device can be operated*. The apparatus taught by Hotta limits the direction in which the cursor can be moved **during** the operation of the mouse. Hotta fails to disclose or suggest defining *the direction in advance*, as recited, for example, in claim 1.

Furthermore, in the Examiner's Response to Arguments in the Office Action, the Examiner asserts Nishimoto teaches a control unit for changing an operational mode of the pointing device. The Examiner asserts Nishimoto discloses, "the pointer moves when the finger is shifted while in contact with the sensor window (operational mode), and if the finger is not shifted while in contact with the sensor window, the pointer does not move (operation mode). Therefore, the control unit inherently changes the operation mode of the pointing device when the finger is shifted while it is contact with the sensor window."

The process taught by Nishimoto is different from the present invention as recited, for example, in claim 1. Claim 1 recites (1) *changing the operation mode of the pointing device according to contents displayed on the display screen at the time the pointing device is operated*. The argument asserted by the Examiner simply describes a process wherein the

pointer does not move because the pointing device is not being operated (non-operational) to a condition wherein the pointing device moves when the user operates it (operational). The process described by the Examiner fails to disclose *changing the operation mode of the pointing device ... at the time the pointing device is operated*, as recited, for example, in claim 1.

Furthermore, Nishimoto fails to disclose *changing the operation mode of the pointing device according to contents displayed on the display screen*, as recited, for example, in claim 1. Therefore, the ability to simply move the pointer from a non-operational mode to an operational mode in Nishimoto is not the same as the present invention as recited, for example, in claim 1.

The Applicants respectfully submits the present invention is patentable over Nishimoto in view of Hotta, because neither reference discloses all the features of the present invention. Therefore, the Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

In view of the above, it is respectfully submitted that the rejection is overcome.

III. CLAIMS 5, 9, 10, 19, 22, 24, AND 26-28 ARE REJECTED UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER NISHIMOTO AND HOTTA IN VIEW OF KIM (U.S. PAT. NO. 6765598)

Each of the dependent claims are patentable for at least the reasons discussed above. Furthermore, the Examiner concedes Nishimoto does not specifically disclose a pointing device and a telephone wherein said control unit has moving amount adjusting means for moving said operational object by a predetermined step value when said pointing device is operated. Therefore, the Examiner relies on Kim to teach the speed of movement of the movable pointer can be adjusted. (citing col. 1, line 67 to col. 2, line 9 and claim 6 of Kim).

While Kim teaches the speed of a movable pointer can be adjusted, Kim does not cure the deficiencies of Nishimoto and Hotta discussed above. Therefore, it would not have been obvious combine Nishimoto and Hotta's pointing device with the pointing device taught by Kim because neither Kim, Nishimoto, nor Hotta alone or in combination, discloses all the features of the present invention. Therefore, the Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

In view of the above, it is respectfully submitted that the rejection is overcome.

IV. CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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